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EXAMINER	
LU, SHIRLEY	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIN IIMA and HIROFUMI KANEMAKI

Appeal 2010-005875
Application 09/920,883
Technology Center 2600

Before ROBERT E. NAPPI, ELENI MANTIS MERCADER, and CARL W. WHITEHEAD, *Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 6(b) of the rejection of claims 1 through 14.

We affirm.

INVENTION

The invention is directed to a communication system which allows the user to select the type of output of additional information such as advertisements the user receives. See Paragraphs 2 of Appellants' Specification. Claim 1 is reproduced below:

> 1. A communication apparatus comprising:
> a receiving means for receiving a signal comprised of a program signal and an additional signal;
> a separating means for separating the program signal and the additional signal from said received signal;
> a determining means for determining whether to output in accordance with said additional signal;
> an output signal generating means for generating an output signal by using said separated program signal and additional signal upon determination to output in accordance with said additional signal and for generating the output signal by using said separated program signal where it is determined not to output in accordance with said additional signal; and
> an outputting means for outputting information in accordance with said generated output signal;
> wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal; and
> wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service.

REFERENCE

Kim (Provisional)	US 60/176,121	Jan. 14, 2000
Kim	US 2002/0010927 A1	Jan. 24, 2002
Zigmond	US 6,698,020 B1	Feb. 24, 2004

REJECTION AT ISSUE

The Examiner has rejected claims 1 through 14 under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Kim. The Examiner's rejection is on pages 3 through 19 of the Answer.[2]

ISSUES

Appellants argue on pages 8 and 9 of the Brief[3] and pages 3 and 4 of the Reply Brief that the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) is in error. Appellants argue that the provisional application upon which Kim derives a claim for priority does not teach simultaneously displaying the program and the additional signal as claimed. Brief 7.

Initially, we note that subsequent to filing of the Briefs and the Answer, we remanded this appeal, on June 8, 2008, for the Examiner to determine whether the application on appeal is entitled to the foreign priority date which would antedate the Kim reference and require a determination as to whether Kim's priority document taught the argued claim limitation. Appellants provided a certified translation of the priority document on

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[2] Throughout this decision we refer to the Examiner's Answer dated November 3, 2006.
[3] Throughout this decision we refer to the Appeal Brief dated September 28, 2006 and Reply Brief dated January 3, 2007.

February 21, 2008. On May 29, 2009, the Examiner identified in an annotation to the file that the certified translation is sufficient under 35 U.S.C. § 112 to support a claim for priority, although it is not clear whether the Examiner communicated this determination to Appellants. Thus, Appellants and Examiner have complied with the order of our January 8, 2008 Remand.

Thus, Appellants' contentions present us with the issue: did the Examiner properly find that the provisional application, upon which Kim derives a claim for priority, teaches that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal?

ANALYSIS

Appellants' arguments have not persuaded us that the Examiner erred in finding that provisional application 60/176,121 (hereinafter 121 application), from which Kim derives priority, teaches that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal. The Examiner finds that page 1 and Figure 2 of the 121 application teach that the video reconstruction unit outputs both the decoded signal (claimed program) and the banner information (claimed additional signal) together, and that this teaching meets the claim simultaneous display. Answer 20. The Examiner further finds that the disclosure on page 4 of the 121 application discusses that Kim's purpose is to allow the user to watch a program along with a commercial advertisement. Answer 21. We concur with the Examiner's findings. We recognize that Kim does not use the word "simultaneously" to

describe the display of the advertisement and the program. The Examiner reasoned that simultaneous display is taught by Kim's combining the decoded video signal and the rendered banner information by the video reconstruction signal to one video output. We find this reasoning to be reasonable. We find no teaching or suggestion in the 121 application that the display of the program information and the banner information is not to be displayed simultaneously, e.g. we find no teaching that the program and banner information are displayed sequentially. Further, we do not consider the portions of the 121 application which Appellants cite to in the Briefs to contradict the findings of the Examiner.

Further, in as much as Appellants' arguments are not intended to be directed to the claimed feature of simultaneous display but rather to the claimed "inside our outside a window of a program" we are similarly unpersuaded. As discussed above, we consider the Examiner's finding that the 121 application teaches simultaneous display is reasonable; hence they are both on the display device at the same time. While it is not clear whether the application teaches the additional display is displayed inside or outside of the same window as the program, the claim is met in either event, i.e. if the additional information is not inside the display window and it is displayed simultaneously, it must be displayed outside the window and the scope of the claim encompasses either situation.

Accordingly, Appellants' arguments have not persuaded us that the Examiner erred in finding that provisional application 60/176,121, from which Kim derives a claim for priority, teaches that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal.

CONCLUSION

Appellant has not persuaded us of error in the Examiner's error in the Examiner's rejection of 1 through 14.

ORDER

The decision of the Examiner to reject claims 1 through 14 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD

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